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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,721	08/24/2001	Tao Shi Gao	A-7432	2074

7590 06/17/2003

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EXAMINER

KOSLOW, CAROL M

ART UNIT	PAPER NUMBER
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1755

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DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-6

Office Action Summary

Application No.

09/935,721

Applicant(s)

GAO, TAO SHI

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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This action is in response to applicants' amendment of 15 May 2003. The 35 USC 12, second paragraph with respect to the misspelling is withdrawn due to the amendment to the claims. The art rejections are withdrawn due to the amendments to the claims. Applicant's arguments with respect to the remaining claims have been fully considered but they are not persuasive.

Claims 1-6 and 12-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a magnetic dispersion medium comprising liquid paraffin, 1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% of electrical steel powder which contains up to 17 wt% manganese, does not reasonably provide enablement for a magnetic dispersion medium comprising a bulk material or liquid paraffin, a first and second colorant, a thickener and a magnetic material or iron powder. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The claims recite a magnetic dispersion medium comprising a bulk material, a first and second colorant, a thickener and a magnetic material. This encompasses compositions comprising any bulk material, colorants, thickeners and magnetic materials in any amounts, as long as the final product is a dispersion. However, the specification only teaches a magnetic dispersion medium comprising liquid paraffin, 1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% electrical steel powder which contains up to 17 wt% manganese. Such a limited disclosure does not support the breadth of the instant claims.

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Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a magnetic dispersion medium comprising liquid paraffin, 1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% electrical steel powder which contains up to 17 wt% manganese, does not reasonably provide enablement for a magnetic dispersion medium comprising a bulk material, a benzo oxazole fluorescent whitener, a thickener and a magnetic material. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The claims recite a magnetic dispersion medium comprising a bulk material, a benzo oxazole fluorescent whitener, a thickener and a magnetic material. This encompasses compositions comprising any bulk material, thickeners and magnetic materials in any amounts and any amount of a benzo oxazole fluorescent whitener, as long as the final product is a dispersion. However, the specification only teaches a magnetic dispersion medium comprising liquid paraffin, 1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% electrical steel powder which contains up to 17 wt% manganese. Such a limited disclosure does not support the breadth of the instant claims.

Claims 1-6 and 10-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed composition is not taught or suggested by the specification. Line 24 on page 2 through line 2 on page 3 teaches a magnetic dispersion medium comprising liquid paraffin,

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1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% electrical steel powder which contains up to 17 wt% manganese, where the steel powder has a particle size of less than 100 microns. This teaching does not support the claimed materials, where the amounts are not given and the composition is not limited to that disclosed in the specification.

Applicant admits that the claims are broader than the enabled dispersion medium in lines 13-14 in the second paragraph of their arguments on page 3 of the response. Accordingly the rejections are maintained.

Claims 1 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 10 are indefinite since it is unclear what is meant by "bulk material".

Applicant did not address this rejection and thus it is maintained.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

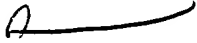
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (703) 308-3817. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (703) 308-3823.

The fax number for Amendments filed under 37 CFR 1.116 or After Final communications is (703) 872-9311. The fax number for all other official communications is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661 or (703) 308-0662.

cmk
June 16, 2003


C. Melissa Koslow
Primary Examiner
Tech. Center 1700